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| 09/763,014      | 05/29/2001  | Maki Wakita          | I0MC-0039           | 1290             |

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EXAMINER

CAO, ALLEN T

ART UNIT

PAPER NUMBER

2652

DATE MAILED: 08/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/763,014

Applicant(s)

WAKITA ET AL.

Examiner

Allen T Cao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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1. Claims 1-12 of this application conflict with claims 1-11 of Application No. 09/762,828. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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3. Claims 1-12 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 of copending Application No. 09/762,828. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

4. The abstract of the disclosure is objected to because many elements disclose in the spec are not consistency with drawings. For example: In spec cites that the upper cover is number 4, the lower cover is number 5, the frame is number 2, the frame plate is number 3, etc... However, in the drawings cite that the upper cover is number 1, the lower cover is number 8, the frame is number 6, and the frame plate is number 15, etc.... Correction is required. See MPEP § 608.01(b).

5. The drawings are objected to because as the reason above in the paragraph No. 4. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dague et al (US. 6,429,999 B1) in view of Patterson (US. 5,995,332).

Dague et al disclose a magnetic recording device having a disk housing space for housing a disk-shaped recording medium; a head arm 60 carrying a magnetic recording/reproducing head 226 and causing the magnetic recording/reproducing head to move between a recording/reproducing position to obtain access to the disk-shaped recording medium loaded in the disk housing space; a frame plate (figure 9) which mounts the head arm and a disk drive device for driving the disk-shaped recording medium loaded in the disk housing space, on one surface thereof; and a circuit substrate 228 located on the other surface of the frame plate in overlap arrangement, having a plurality of elements arranged on the surface opposite to the surface facing the frame plate.

Dague et al neither disclose that the medium is a card type, nor that the frame plate has an "opening or a concave" part allowing the magnetic recording/reproducing head placed in the standby position and/or a part of the head arm to be housed therein, allowing the magnetic recording/reproducing head to move between the standby position and the recording/reproducing position without interference with the frame plate.

Patterson discloses a card type magnetic recording device having a frame plate including an "opening or a concave" part (figure 4A) allowing the magnetic recording/reproducing head

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placed in the standby position and/or a part of the head arm to be housed therein, allowing the magnetic recording/reproducing head to move between the standby position and the recording/reproducing position without interference with the frame plate.

It would have been obvious to one of ordinary skill in the art the time the invention was made to modify the disk drive assembly of Dague et al with such card type medium and the frame plate as set forth, supra as taught by Patterson to prevent damages might occurred to the medium during movement of the head arm in the standby position.

Regarding claims 8 and 9, Dague et al disclose ICs of the printed circuit board as claimed.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dague et al and Patterson and further in view of Ho et al (US. 5,875,074).

Dague et al and Patterson do not disclose that the head arm is composed of an upper arm carrying the head to gain access to the upside of the disk and a lower arm carrying the head to gain access to the underside of the disk as claimed.

Ho et al disclose a disk drive having the head arm is composed of an upper arm carrying the head 130-u to gain access to the upside of the disk 110-u and a lower arm carrying the head 130-l to gain access to the underside 110-l of the disk as claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the head and disk of Dague et al as modified by Patterson with upper and

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lower heads and disk sides as set forth, supra as taught by Ho et al in order to improve the capacities of read/write characteristics.

9. Claims 3-7<sup>812</sup> are rejected under 35 U.S.C. 103(a) as being unpatentable over Dague et al and Patterson as applied to claim 1 above, and further in view of Shimazu et al (US. 5,841,606).

Dague et al disclose a shield sheet 225 adhered to the frame plate. However, Dague et al and Patterson do not disclose that the shield is an electromagnetic shield.

Shimazu et al disclose a disk drive having a printed circuit 17a, a voice coil 17 and a noise magnetic shield (electronic magnetic shield) 17b.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shield of Dague et al as modified by Patterson including "electronic magnetic" shield as taught by Shimazu et al in order to reduce noise.

Shimazu et al also disclose that the shield is made of copper material.

10. Claims 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

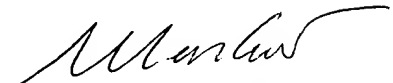
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Janik et al (US. 6,411,463 B1) disclose a disk drive including an electromagnetic shield 150.

Bernnet (US. 6,30,723 B1) disclose a disk drive including a printed circuit board.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen Cao whose telephone number is (703) 305-3796.

  
ALLEN CAO  
PRIMARY EXAMINER

AC

August 19, 2002